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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,500	07/12/2001	John K. Eckl	F-278	5429

919	7590	12/14/2004

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EXAMINER
MYHRE, JAMES W

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/903,500	ECKL, JOHN K.
	Examiner	Art Unit	
	James W Myhre	3622	NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>10 September 2004</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *12 and 14-36* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *12 and 14-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114 was filed in this

application after a decision by the Board of Patent Appeals and Interferences, but

before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or

the commencement of a civil action. Since this application is eligible for continued

examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been

timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution

in this application has been reopened pursuant to 37 CFR 1.114. Applicant's

submission filed on September 10, 2004 has been entered.

Response to Amendment

2.   The amendment filed on September 10, 2004 has been considered but is

ineffective to overcome the Comesanas (5,802,498) and Hogan (5,699,528) references.

The amendment amended Claims 12, 18, and 19. The pending claims considered

below are Claims 12 and 14-36.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 12, 14, 15, 17-23, 25-27, 29-34, and 36 are rejected under 35

U.S.C. 103(a) as being unpatentable over Comesanas (5,802,498).

Claims 12 and 18: Comesanas discloses an automated billing system and

method comprising:

        a. A billing server to receive billing information (col 2, lines 55-66);

        b. A routing means for processing/routing the information to a printer or to

the electronic information server (col 3, lines 4-24 and col 4, lines 50-53);

        c. A printer connected to the server (col 3, lines 4-24 and col 4, lines 50-

53);

        d. An electronic information server to convert the billing information for

electronic transmission and to transfer the electronic billing statement to the customer

(col 3, lines 4-24 and col 4, lines 50-53); and

        e. A lookup table containing the delivery preferences from each customer.

While Comesanas does not explicitly disclose that the delivery preferences

desired by the customer(s) are maintained in a lookup table, it is inferred that this

information is being stored in some type of data file. Since Comesanas explicitly

discloses that the system will "determine whether each of the debtors has signed an

agreement to pay transmittal charges (col 4, lines 44-46)(i.e. selected electronic

transmission of the billing invoice) and will determine "whether each of said invoices is

to be sent electronically or by mail" (col 4, lines 50-52), it is inherent that the system must look up both preferences, using one of the standard "lookup" devices in the database arts such as lookup tables.

Comesanas also does not explicitly disclose converting the billing information to the proper format for printing or for electronically transmission; however, Official Notice is taken that it is old and well known within the communications art to convert data to the appropriate format for transmission, such as HTML for electronic transmissions and the appropriate print file type for the system printer. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the data in Comesanas' system was being converted to the proper format for printing or electronic transmission.

Claim 14: Comesanas discloses an automated billing system and method as described in Claim 12 above, and further discloses the billing server containing billing information about a plurality of recipients (customers) which separates the billing information corresponding to individual recipients (col 3, lines 35-39).

Claim 15: Comesanas discloses an automated billing system and method as in Claim 12 above and further discloses an inserter (collation) connected to the printer (col 3, lines 35-39).

Claims 17 and 20: Comesanas discloses an automated billing system and method as described in Claims 12 and 18 above and further discloses a means to transmit funds to the biller (col 3, lines 13-24).

Claim 19: <u>Comesanas</u> discloses an automated billing system and method as described in Claim 18 above and further discloses the customer completing a written agreement delineating the customer's preferences on the type of billing, the charges authorized to be collected, etc. (col 3, lines 4-24) and storing them in a database. However, <u>Comesanas</u> does not explicitly disclose that the customers' preferences are stored as a lookup table in the database. Official notice is taken that it is old and well known within the database art to place use a table format to save memory space when storing such data. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a table to store the customer's selection of delivery means. One would have been motivated to use a lookup table in order to minimize the amount of memory required to store the information for a large number of customers. By placing the data in a table, each customer's file could have a one-bit identifier for the type of delivery instead of a much larger field to store the delivery instructions.

Claims 21, 26, 30, and 32: <u>Comesanas</u> discloses an automated billing system, apparatus, and method comprising:

        a. Accessing billing information comprising a plurality of records (col 2, lines 55-66) corresponding to one recipient;

        b. Isolating each record from the billing information (col 2, lines 55-66);

        c. Extracting delivery preference information from the database for each record (col 3, lines 17-24 and col 4, lines 50-52);

       d. Determining whether each record is intended for printed or electronic transmission based on delivery preference information received from the customer (col 3, lines 17-24 and col 4, lines 50-52);

       e. Converting the billing information for electronic transmission and transmitting the electronic billing statement to the customer (col 3, lines 4-24 and col 4, lines 50-53);

       f. Routing the billing information to a printer or to the electronic information server (col 3, lines 4-24 and col 4, lines 50-53);

Comesanas does not explicitly disclose converting the billing information to the proper format for printing or for electronically transmission; however, Official Notice is taken that it is old and well known within the communications art to convert data to the appropriate format for transmission, such as HTML for electronic transmissions and the appropriate print file type for the system printer. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the data in Comesanas' system was being converted to the proper format for printing or electronic transmission.

Comesanas also does not disclose the feature in Claim 30 wherein the switch routes all of the record to the printer if the server fails or is taken out of service. Official Notice is taken that it is old and well known with the communications art to redirect output to another format/device when part of the network fails or is otherwise not available. In this instance, it would have been obvious to one having ordinary skill in the art at the time of invention was made to redirect the electronic bills in the Comesanas

invention to the printer and to then transmit the bills through the normal postal channels.

One would have been motivated to do so in order to facilitate timely transmission of the

bills and receipt of payments, thus decreasing the financial loss to the crediting

organization and to the customer (through the levying of "late charges").

Finally, while <u>Comesanas</u> discloses retrieving the customer's billing preference

from a database, it is not explicitly disclosed whether this is the same database that

contains the billing data or a separate database. Official Notice is taken that it is old

and well known within the database arts that data may be stored in one, two, or more

databases and then combined as needed. This is referred to as a multidatabase

(MDBS) system and has been in use for many years. One of the main advantages of

an MDBS is its ability to "access data from a variety of preexisting" (legacy) "databases

located in various heterogeneous hardware and software environments." (<u>Korth and</u>

<u>Silberschatz</u>, "Database System Concepts", 1991, page 518). It is also common for

businesses to store transaction information (billing data) in one file or database and to

store customer data (such as name, address, phone, billing and payment preferences,

etc.) in a different file or database, and then extract the needed data when compiling

bills, reports, etc. The two main reasons that this data is kept separate is: (1) to

decrease the required storage space by eliminating storing duplicate information, such

as the customer's name and address, with each transaction completed during the billing

period; and (2) to facilitate updating the customer's data, such as address, by

eliminating the need to search for and replace every instance of the data if duplicate

data is maintained as in (1) above. Therefore, it would have been obvious to one

having ordinary skill in the art at the time the invention was made to maintain the

customer data in the Comesanas invention in a database separate from the billing data.

One would have been motivated to maintain separate databases for the reasons

discussed above.

Claims 22 and 27: Comesanas discloses an automated billing system and

method as described in Claims 21 and 26 above and further discloses the customer

completing a written agreement delineating the customer's preferences on the type of

billing, the charges authorized to be collected, etc. (col 3, lines 4-24) and storing them in

a database.

Claims 23 and 34: Comesanas discloses an automated billing system and

method as in Claim 21 and 30 above and further discloses an inserter (collation)

connected to the printer (col 3, lines 35-39).

Claims 25, 29, and 36: Comesanas discloses an automated billing system and

method as described in Claims 21, 26, and 30 above and further discloses a means to

electronically transmit funds to the biller (col 3, lines 13-24).

Claim 31: Comesanas discloses an automated billing system and method as

described in Claim 30 above, and further discloses the billing server containing billing

information about a plurality of recipients (customers) which separates the billing

information corresponding to individual recipients (col 3, lines 35-39).

Claim 33: Comesanas discloses an automated billing system and method as

described in Claim 31 above, but does not disclose that each record is sanitized.

Examiner notes that Applicant has defined "sanitized" in the specification (page 3, lines

24-27) as a filter "which performs a number of convenient functions, such as verifying

and/or correcting the accuracy of a customer's address, etc.". Official Notice is taken

that it is old and well known within the accounting and database arts to verify and

correct data such as addresses, phone numbers, etc. in order to maintain the most up-

to-date database as possible. Therefore, it would have been obvious to one having

ordinary skill in the art at the time the invention was made to include a means to verify

and correct the information within the databases in Comesanas. One would have been

motivated to verify and update the information to ensure that the bills are directed to the

correct address, thus precluding the wasteful expenditure of time and funds.

5.   Claims 16, 24, 28, and 35 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Comesanas (5,802,498) in view of Hogan (5,699,528).

        Claim 16: Comesanas discloses an automated billing system as in Claim 12

above, but does not disclose determining whether or not the recipient has received and

viewed the information. Hogan discloses a similar automated billing system and

method in which the server determines whether or not the recipient has reviewed the

information (col 10, lines 13-21). Therefore, it would have been obvious to one having

ordinary skill in the art at the time the invention was made to include such a

determination method in Comesanas' electronic billing processor. One would have

been motivated to include a determination method in order to verify the customer had

received and opened the electronic bill and to ensure the correctness of the information

within the database. Non-receipt and/or non-viewing of the bill could indicate the need

to update of the information.

Claims 24, 28, and 35: <u>Comesanas</u> discloses an automated billing system as in

Claim 21, 26, and 30 above, but does not disclose determining whether or not the

recipient has received and viewed the information. <u>Hogan</u> discloses a similar

automated billing system and method in which the server determines whether or not the

recipient has reviewed the information (col 10, lines 13-21). Therefore, it would have

been obvious to one having ordinary skill in the art at the time the invention was made

to include such a determination method in <u>Comesanas</u>' electronic billing processor.

One would have been motivated to include a determination method in order to verify the

customer had received and opened the electronic bill and to ensure the correctness of

the information within the database. Non-receipt and/or non-viewing of the bill could

indicate the need to update of the information.

Response to Arguments

6.   Applicant's arguments filed September 10, 2004 have been fully considered but

they are not persuasive.

The Applicant has amended three of the claims to clarify that the delivery

preferences are those of the customer, i.e. received from the customer. The Examiner

notes that <u>Comesanas</u> explicitly discloses that the customer has submitted an

agreement to either pay the electronic transmission fee or the return postage fee.

<u>Comesanas</u> gives the customer one further option for a billing preference, that of

delivery by mail without a prepaid return envelope. By agreeing to pay one of these

fees, the customer has indicated the desired method of billing - - electronic or by mail.

Furthermore, even when selecting to receive the billing statement by mail, the customer

may further indicate whether or not it is desired to receive a prepaid return envelope by

agreeing to either pay or not pay the return postage fee. Therefore, the customer in

Comesanas has indicated which of the three delivery methods is preferred.

Conclusion

7.   All claims are drawn to the same invention claimed in the application prior to the

entry of the submission under 37 CFR 1.114 and could have been finally rejected on the

grounds and art of record in the next Office action if they had been entered in the

application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE**

FINAL even though it is a first action after the filing of a request for continued

examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
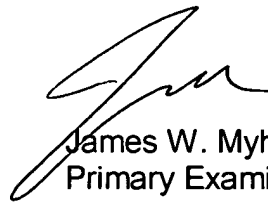
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached Monday through Thursday from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.

JWM
December 10, 2004

James W. Myhre
Primary Examiner
Art Unit 3622